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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/103,110 06/23/98 ESKILDSEN

S 042390.P5444 *u*

MM92/1116  
BLAKELY SOKOLOFF TAYLOR AND ZAFMAN  
12400 WILSHIRE BLVD  
7TH FLOOR  
LOS ANGELES CA 90025

EXAMINER

DINH, T

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 11/16/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/103,110	Applicant(s) ESKILDSSEN ET AL.	
	Examiner Tuan T Dinh	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Prosecution Application***

The request filed on 10/26/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/103,110 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claims 1, 7, and 13, they are unclear. The applicant states that "an IC package having multiple leads extending away from the IC package" also, he further claims that " a portion of the multiple leads is not on the IC package". It is contradiction in claimed invention. Are the leads extending away from the IC package and are not on the IC package 's housing?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 are rejected under 35 U.S.C. 102(a) as being anticipated by Wakabayashi et al (5, 659, 459).

As to claim 1, Wakabayashi discloses an IC card (503) as shown in figures 1-11 comprising an IC package (550) having multiple leads (551) extending away from the IC package and not on the IC package. A casing (100, 120) encases the package without the use of the printed circuit board and connector (column 10, lines 1-5, column 16, lines 33-41).

As to claim 2, Wakabayashi discloses an IC card as shown in figure 1 wherein the casing having a front surface including a front opening.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over as Wakabayashi et al in view of Banjo et al (U. S. Patent 4,926,034).

As to claims 3 and 4, Wakabayashi discloses all of the limitations of claimed invention, except for the IC card having a surface including a back opening, and there are at least one stop at the back opening. Banjo teaches the IC card (100) as shown in figure 4A-4C comprising a bottom surface having a bottom opening (2) and including at least one stop (21) at the back opening to hold the IC package in the casing (column 2, lines 62-65, column 3, lines 5-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IC card of Wakabayashi and provide the back surface having an opening including the stop for holding the IC card into the casing as taught by Banjo because it is design choice of the IC card having an opening on the back of the card for insert the card into the casing of the IC card and the stops that has function to hold and secure the card into the casing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al in view of Ochi et al (U. S. Patent 5,735,040)

As to claims 5-6, Wakabayashi discloses an IC card and satisfies all of the limitation of the claims, except for the IC card wherein the casing having the bottom surface that has a bottom opening, and the casing has at least one stop at the bottom opening. Ochi shows the IC card (10) having the casing that has the bottom surface including the opening (2a), the casing has at least one stop (20) (column 3, line 65-67, column 4, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IC card assembly of Wakabayashi and provide the casing of the IC card that has bottom surface including an opening and stop to hold the IC package as taught by Ochi because it is design choice of the IC card having an opening at the bottom of the card for insert the card into the casing of the IC card and the stops that has function to hold and secure the card into the casing.

Art Unit: 2841

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al in view of Banjo et al and Ochi et al.

Regarding to claims 7-14, the method steps are necessitated by the IC card structure as it is disclosed by Wakabayashi in view of Banjo and Ochi.

***Response to Arguments***

Applicant's arguments filed 10/26/00 have been fully considered but they are not persuasive. The applicant states: (1) Wakabayashi does not disclose an IC package having multiple leads extending away from the IC package. (2) Wakabayashi does not disclose the leads that are not on the IC package. (3) The leads provided an electrically interface between the IC package and a data processing device without using a printed circuit board and a connector. Examiner disagrees. Wakabayashi clearly teaches all of the limitations as shown in figures 1-3, and 8-11. In figures 1-3, Wakabayashi shows the multilayer circuit card (550) having multiple leads (551) and its portion extending away from the IC card and the leads portion are not on the card's housing. Also, in figures 8-11, Wakabayashi teaches the IC package that is electrically interfaced with a data processing device (laser printer). The cartridge is fit in the laser printer as shown in figures 10-11.

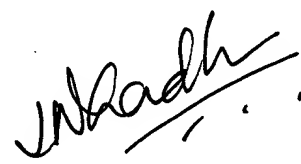
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3431 for regular communications and 703-308-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4900.

TD  
November 14, 2000

  
Jayprakash N. Gandhi  
Primary Examiner  
Technology Center 2800